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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/509,524

09/28/2004

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6009-4714

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03/21/2008

EXAMINER

BELL, BRUCE F

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/509,524	<b>Applicant(s)</b> KIVISTO ET AL.	
	<b>Examiner</b> Bruce F. Bell	<b>Art Unit</b> 1795	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5,6,8 and 10-12 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is vague and indefinite with respect to how the entire device can be plastic, since claim 1 now recites that the device includes the electrode which means that the device can not be entirely plastic as is now claimed in claim 3.

Claim 12 is vague and indefinite with respect to how the recitation that the electrode is an anode further limits the electrodes structure. The recitation that the electrode is an anode is the manner in which it is hooked up, therefore, the electrode structure has not been further limited in any manner. A method of use is not a structural limitation.

Correction and/or clarification are requested.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 5, 6, 8, 10, 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Galloway et al (2004/0087838).

Galloway et al disclose a stylus or probe 42 and an electrode 44 that are coupled to a primary base unit 18 or a meridian linking device 14. Two cables come out of the meridian linking device 14, which are a negative lead 36, and positive lead 40. The negative lead is attached to electrode 38 and the positive lead 40 is attached to the probe 42 by an insulated handle 41 and presses tip 44 against one of the patients acupuncture points. See paragraph 0085 and Figure 3.

The prior art of Galloway anticipates the applicants instant invention as set forth in the instant claims as presented. A device that has a transfer and insulation portion (probe 42) that is of single piece (see figure 3 and paragraph 0085) that is attached to an electrode 38 (attached by being inside the probe handle) is disclosed. The device is made of an insulating piece which in these types of devices are plastic. The device has a fastening point for fastening the insulating portion to an end of a suspension rod ( in this case lead 40) wherein the insulation portion at least partly surrounds the suspension bar through the device (i.e. the lead 40 goes into the probe handle and therefore the lead wire is the suspension bar and the probe handle is the insulation portion). The grip lug is construed by the examiner to be that of the probe handle and it does enable the electrode to be transferred from any place that it would sit, to the patients hand. The grip lug is provided with an inclined part, which is construed by the examiner to be that of the lead wire as that would allow for the inclined, decline or

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straight manipulation of the probe containing the electrode to be placed in to the patients hand and the distribution element is construed to be that of the meridian linking device in that it aids in the insulating of the adjacent electrodes from each other through the electronics used or the electrodes would short out. Therefore, the prior art of Galloway et al anticipates the applicants instant invention for the reasons set forth above.

The examiner in charge of this application would like to point out that even though the instant invention is set forth in the instant specification to be directed to a transfer and insulation device that holds an electrode of a cathode plate, the instant claims as set forth are broader than there disclosure and therefore, the prior art of Galloway et al does in fact anticipate the applicants instant claims, even though it is directed to an electrode used in medical applications. Further, in order to overcome this rejection an English Certified Translation of the foreign priority document is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Galloway et al (2004/0087838) in combination with Yan et al (6099600).

Galloway et al is as disclosed above in the 35 USC 102(e) rejection above.

Galloway et al does not disclose that the device is made of a chemically resistant and insulating material.

Yan et al disclose the use of ETFE which is a known insulating material that is chemically resistant and is used in applications such as those of implantable medical devices. See col. 35, lines 1-54.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the instant invention was made because even though the prior art of Galloway does not disclose what the insulating material is other than a plastic, one having ordinary skill in the art would be motivated to use a chemically resistant material of ETFE since it is shown in the Yan et al patent that this material is known to be chemically resistant and to be used in implantable medical devices where the electrolytes used would deteriorate regular plastics. Therefore, one having ordinary skill in the art would use this material in the prior art invention of Galloway et al to improve the probes resistance to chemical breakdown of the probe to extend the life of the probe having the electrode enclosed within the probe and to further protect the electrode portion inside of the probe from any kind of electrical breakdown. Therefore, the prior art of Galloway et al in combination with Yan et al render the applicants invention as obvious for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce F. Bell whose telephone number is 571-272-1296. The examiner can normally be reached on Monday-Friday 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BFB  
March 16, 2008

/Bruce F. Bell/  
Primary Examiner, Art Unit 1795